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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/627,270 04/04/96 TOJO

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EXAMINER

QM11/0216

WEINER CARRIER & BURT  
MAXIM BLDG  
42400 GRAND RIVER AVE  
SUITE 207  
NOVI MI 48375

GORSKI, J

ART UNIT

PAPER NUMBER

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UNITED STATES DEPARTMENT OF COMMERCE  
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 14

Application Number: 08/627270  
Filing Date: April 4, 1996  
Appellant(s): Tojo et al.

**MAILED**

**FEB 16 1999**

**GROUP 3200**

Weiner Carrier & Burt  
For Appellant

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed November 30, 1998.

A statement identifying the real party in interest is contained in the brief.

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

Art Unit:

The statement of the status of the claims contained in the brief is correct.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The summary of invention contained in the brief is correct.

The appellant's statement of the issues in the brief is correct.

Appellant's brief includes a statement that claims 20, 26, 27, 30-33 and 37 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The copy of the appealed claims contained in the Appendix to the brief is correct.

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,428,880	Tomioka et al.	7-1995
Applicants admitted prior art as described on pages 1 - 4 of the specification (AAPA).		

Art Unit:

### **Grounds of Rejection**

Claims 20, 26, 27, 30-33 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of AAPA and Tomioka et al..

On page 1, lines 13 - 21 of the instant specification, the painting of an automobile followed by the application of a rust preventing wax is stated to be prior art.

On page 2, lines 7 - 8 of the specification, forming a protective coating on small parts by coating a strippable paint thereon is stated to be prior art. These parts are presumed to be assembled to other parts or have other parts assembled thereto after the coating operation, and presumed to be stored once coated.

Tomioka et al. Teaches assembling an automobile, by mounting an engine and functional parts thereto, after painting the automobile. See column 1, lines 30 -35.

In view of these teachings, taken as a whole, one having ordinary skill in the art would have found it obvious at the time of Appellant's invention to paint those members of the automobile that require painting (e.g. trunk lids, doors and bodies), then coat these members with a strippable paint for protection purposes, then store these members until their assembly is required, and then forming the automobile by assembling these members to one another along with the mounting of an engine and functional parts thereto. The method as recited in claim 20 reads on this combination of prior art.

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The subject matter of claim 26 would have been obvious to one having ordinary skill in the art, because it is known in the art to inspect assembled and painted products for quality assurance.

The subject matter of claims 27, 30 - 33 and 37 are held to be matters of engineering design choice because the steps of “preliminarily drying”, “non-preliminarily drying” and “stabilizing”, as well as the manner by which these steps are performed, solve no stated problem nor serve any apparent purpose.

Initially in this regard, the specification in the paragraph bridging pages 14 and 15 explains the significance of drying the strippable paint by subjecting it to infrared radiation. Namely, the infrared radiation causes the water-soluble strippable paint to be dried from the inside out such that holes or cracks are prevented from being formed in the surfaces of the strippable paint after it has completely dried. However, the claims do not require that the strippable paint is “water-soluble” nor that the infrared radiation causes the strippable paint to be dried from the “inside out”. Accordingly, because the claims fail to provide a nexus between the “preliminarily drying” step and its significance, the performance of this step is properly held to be a matter of engineering design choice.

Secondly, the complete paragraph on page 15 of the specification explains the significance of non-preliminarily drying the strippable paint by subjecting it to hot air. Namely, by passing the automobile through a hot air drying furnace uniform heat is applied thereto. However, the claims do not require that the automobile is passed through a “hot air

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drying furnace” nor that the hot air “uniformly heats” the automobile or strippable paint.

Accordingly, because the claims fail to provide a nexus between the “non-preliminarily drying” step and its significance, the performance of this step is properly held to be a matter of engineering design choice.

Finally, the specification fails to explain any significance of the “stabilizing” step, whereby this step is also properly held to be a matter of engineering design choice. Indeed, if the subject matter of claims 27, 30-33 and 37 were allowed, Appellant would be provided protection for a process in which the strippable paint is a non water-soluble paint which is preliminarily dried from the outside in and then non-preliminarily dried in a non-uniform manner, such that holes or cracks are formed in the coating of the strippable paint. This is contrary to what Appellant is apparently seeking protection.

### **Response to Argument**

Appellant argues that the proposed combination of references is not based on any teaching or suggestion which may be fairly gleaned from the prior art. However, in Tomioka et al.’s Summary of the Invention, benefits to be realized by “painting prior to assembling” are explained, and one of ordinary skill in the art realizes benefits that a strippable paint exhibits relative to a rust preventive wax. In order to realize these benefits, one would have

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found it obvious to combine the references as proposed by the examiner. Thus, the combination of references is based solely on teachings or suggestions gleaned from the prior art and not from Appellant's disclosure.

While the combination of references may not provide any motivation for applying a strippable paint to an automobile as an intermediate step in a "continuous" assembly operation, the combination of references does provide a motivation for applying a strippable paint to parts of an automobile that are to be "stored" and assembled subsequently.

On pages 12-15 of the Brief, Appellant argues that the subject matter of claims 27, 30-33 and 37 are not matters of design choice because, these steps result in significant advantages as expressed on pages 14-15 of the specification. However, as explained in the Grounds of Rejection, supra, the claims provide no nexus between these advantages and the claimed method steps, and would provide protection to methods that are contrary to these advantages. Accordingly, the subject matter of claims 27, 30-33 and 37 are properly held to be matters of design choice.

The following are questions, which when addressed would enable one of ordinary skill in the art to more fully appreciate Appellant's invention.

1) How does Appellant's invention remedy the problems of "non-uniformity", "damage caused by adhering matter" and the "other problems" referenced by Appellant in the initial complete paragraph on page 4 of the Brief?

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2) How has Appellant eliminated the need for a scratch cover? Is the strippable paint rugged enough to prevent the car body from being scratched or dented during assembly of parts thereto? What is the composition of the strippable paint? What is the thickness of the coating of the strippable paint?

3) How does Appellant prevent the strippable paint from entering the windshield washer nozzles?

4) How does the manner by which Appellant applies the coating of strippable paint differ from conventional coating techniques?

5) Are the small parts referenced on page 2, lines 7-8 of Appellant's specification, assembled after they have been coated with the strippable paint?

6) What are the small parts referenced on page 2, lines 7-8 of the specification?

7) Is it known to "stabilize", "preliminarily dry" and "non-preliminarily dry" a coating applied to an object?

8) How is the coating of strippable paint applied to the small objects (page 2, lines 7-8) dried?

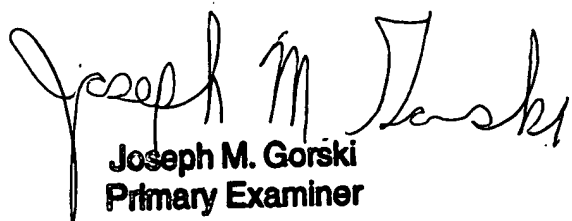
It should be noted that questions 5) and 7) were presented to Applicant as part of paper no. 11, but were never expressly addressed by Applicant.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Joseph M. Gorski  
Primary Examiner